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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/561,915

04/10/2006

Jean-Luc Clement

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466 7590 08/20/2008

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EXAMINER

MERENE, JAN CHRISTOP L

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

08/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/561,915	Applicant(s) CLEMENT ET AL.	
	Examiner JAN CHRISTOPHER MERENE	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/22/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is the initial Office action based on the 10/561,915 application filed on April 10, 2006, which is a 371 of PCT/IB04/02395 filed on June 24, 2004, which also claims benefit to US Provisional No. 60/490,516 filed on July 29, 2003 and Foreign Priority to France 03/07779 filed on June 27, 2003.

Information Disclosure Statement

2. The information disclosure statement filed December 22, 2005 (Foreign Patent Documents) fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Specification

3. The disclosure is objected to because of the following informalities: Page 1 line 20 recites "immobilisation," the examiner assumes the applicant meant to disclose – immobilization--.

Appropriate correction is required.

4. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 1-12** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Regarding claim 1, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

8. Claims 5-7, 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 5, 10-12 recites the limitation "flexible structure." There is insufficient antecedent basis for this limitation in the claim. Also, the use of comas in claims 5, 10-12 (i.e. "extension piece is, outside said end distal portion, of flexible structure") also make the claim unclear and grammatically awkward. The examiner will treat the claims with art in view of the 112 rejections.

9. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

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Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

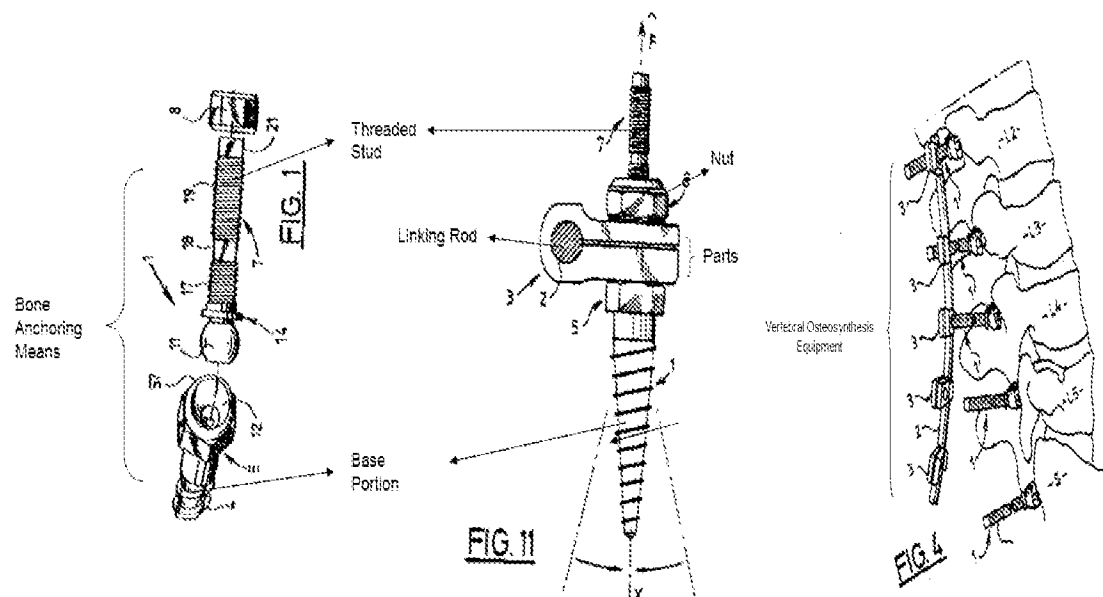
11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. **Claims 1-4, 8, 9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al US 6,267,765 in view of Asnis et al US 5,217,462.

Taylor et al discloses a vertebral osteosynthesis equipment, including: bony anchoring members comprising a proximal threaded stud intended a base portion intended for anchoring to a vertebra; a linking rod intended to be connected to these anchoring members and to be attached to the vertebrae by these anchoring members, parts for connecting the rod to the anchoring members (as seen Figs 1-7 and best seen in the Figs labeled below, where Taylor et al discloses equipment for vertebral oseosynthesis).



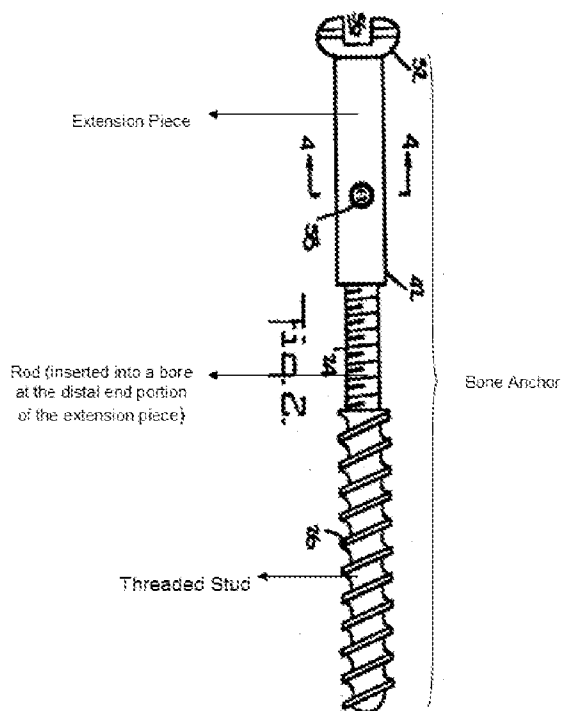
However, Taylor et al does not explicitly disclose an extension pieces with positioning means to connect the extension piece to the threaded stud. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the threaded stud of Taylor et al to comprise of two structures, a threaded stud and extension piece, since it has been held that constructing

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a formerly integral structure in various elements involves only routine skill in the art.

Nerwin v. Erlichman, 168 USPQ 177, 179.

However, Asnis et al discloses a threaded stud with an extension piece with positioning means of a rod and tapered/threaded bore (see Fig below and see Col 3 lines 1-15).



It would have been obvious to one having ordinary skill in the art to modify the threaded stud of Taylor et al to comprise of two portions, where one portion (threaded stud) has a rod to be inserted into the tapered/threaded bore of the other portion (extension piece), wherein both pieces are extendable and both portions are axially connected, as taught by Asnis et al because the lengths of the screw can be modified as desired (see Col 3 lines 60-63).

With regards to Claim 8, the examiner notes that the modification of Asnis et al is to take the unitary threaded stud of Taylor to separate it into two portions, with an extending rod and receiving bore (within distal end of the extension plate) respectfully (as seen above), wherein both portions are threaded and capable of receiving a nut therethrough.

14. **Claims 5-7, 10-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al US 6,267,765 and Asnis et al US 5,217,462 as applied to claims 1-4, above in further view of Beyar US 2002/0095181.

Taylor et al and Asnis et al disclose the claimed invention as discussed above but does not specifically disclose the extension piece outside the end distal portion is of flexible structure, wherein the flexible structure is in the form of a metal wire wound into a spiral, where the spires of the metal wire are contiguous.

However Beyar discloses various bone anchors with a flexible structure, with a wire wrapped around a bone anchor, where the spires of the wire are contiguous (see paragraph 112 and 114).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the flexible structure of Taylor et al and Asnis et al to include the flexible structure Beyer because it applies a known technique to known device to yield predictable results of forming threads on a screw (see paragraphs 112 and 114).

The examiner notes that Bayer does not specifically disclose the wire is made out of metal, but paragraph 115 discloses the screw is made out of steel, where it would

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be obvious to one having ordinary skill in the art at the time the invention was made to also have the wire be a metal, such as steel, since wires are generally made out of metal and metals such as steel are biocompatible/medical grade (see paragraph 115).

Conclusion

The prior art made of record and relied upon is considered pertinent to the applicant's disclosure. See PTO-892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAN CHRISTOPHER MERENE whose telephone number is (571)270-5032. The examiner can normally be reached on 8 am - 6pm Mon-Thurs, alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jan Christopher Merene/

Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733